

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that Examiner telephone the undersigned at (858) 552-1311 or (805) 748-0594 so that such issues may be resolved as expeditiously as possible.

Turning to the specific objections and rejections:

1. The listing of references in the specification is objected to as failing to constitute a proper Information Disclosure Statement under 37 C.F.R. § 1.98(b). An Information Disclosure Statement (IDS) listing all patent, publications, and other information cited in the present patent application, will be filed shortly. Thus, upon filing of the Information Disclosure Statement, this objection should be overcome. Reconsideration and withdraw of this objection is respectfully requested.

2. The drawings stand objected to as being acceptable for examination purposes only. Formation drawings will be submitted upon receipt of a NOTICE OF ALLOWABILITY.

The drawings stand further objected to for failing to comply with 37 C.F.R. § 1.84(p)(5) as not including a reference sign mentioned in the specification: reference number 530, referred to at page 34, line 5. A drawing amendment is submitted herewith in order to overcome this objection.

The drawings stand also objected to for failing to show every feature of the invention as claimed: the package tracking identifier in incorporated on the package, the package in which the electronic medium is stored, and coupling the package with the computer. A drawing amendment is submitted herewith in order to overcome this objection, and a corresponding amendment to the specification is made to add references numerals added by way of this drawing amendment. Furthermore, Claim 1 has been amended to recite coupling the electronic storage medium, not the package, to the computer.

As drawing amendments are submitted herewith in order to address each drawing objection, reconsideration and withdraw of this objection is respectfully requested.

3. The specification stands objected to for including numerous informalities. Amendments are submitted herewith in order to address each specific objection to the specification. Accordingly, this objection should be overcome; reconsideration and withdraw of this objection is respectfully requested.

4. Claims 6 through 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claim 6 has been amended herewith to recite a *tracking* identifier of content on the optical disc electronic storage medium. Therefore, the limitation of "the tracking information" recited in Claims 6 through 10 has sufficient antecedent basis, and the rejection of Claim 6 and Claims 7 through 10 depending thereon should be overcome.

Claim 11 has been amended herewith to recite a *tracking identifier incorporated on an electronic storage medium, and a package having a tracking identifier incorporated on a package*, therefore. Thus, the limitation of "package" recited in Claims 11 through 18 has sufficient antecedent basis, and the rejection of Claim 11 and Claims 12 through 18 depending thereon should be overcome.

Reconsideration and withdraw of all rejections under 35 U.S.C. § 112, second paragraph, is therefore respectfully requested.

5. Claims 1, 2, 4, 6, 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,860,068 (Cook) in view of U.S. Patent No. 5,960,398 (Fuchigami et al.).

Cook teaches a method for manufacturing and distributing custom data products, especially a personalized audio CD product incorporating customer-selected musical sound recordings. According to Cook, a customer generates an order of a custom product through, for instance, a computer terminal having access to a network. A set of digital audio files is selected according to a customer's order, and is transmitted to one of a plurality of a CD burners in a "disk farm".

Although Cook teaches that a bar code or similar identifier identifying the personalized audio CD product, such as by order number, shipping method, job number, or batch number, may be printed at the burner machine and placed on the packaging (see col. 10, lines 23 through 45), and further suggests that hidden "codes" may be implanted in the sound recording to later facilitate tracking (see col. 9, lines 17

through 25), Cook does not teach or suggest "logic . . . that determines, as a function of the tracking information, appropriate updated information to transmit to the computer," as claimed by Applicant in, for example, amended Claim 6. In fact Cook does not suggest or describe any apparatus that includes "logic that detects the tracking information when the electronic medium is coupled with a computer," let alone such an apparatus that further includes "logic that transmits the tracking information [i.e., the tracking information detected when the electronic medium is coupled to a computer,] to a server computer," as claimed, for example in amended Claim 6. All examined claims contain limitations analogous to the limitations of Claim 6 quoted above.

Moreover, although Cook teaches that a bar code or similar identifier may be placed on a package of an electronic medium, i.e., not on the electronic medium, this bar code is "read" only for the purpose of shipping management, i.e., order tracking, not for determining, as a function of the tracking information, appropriate updated information to transmit to a computer, as claimed by Applicant.

Fuchigami et al. teach a copyright information embedding system, in which information for copyright protection is embedded into a digital audio signal "without" deterioration of analog audio signal reproduced. (Presumably, this is the same reason Cook refers to "implanting" hidden codes into his sound recording, although it is not clear from Cook why this is done. See col. 9, lines 17 through 25.) The purpose of the copyright information embedding system is entirely different from the order tracking function taught by Cook. Like Cook, Fuchigami et al. do not teach or suggest

Amendment
S.N. 09/295,856
Page 15

"logic . . . that determines, as a function of the tracking information, appropriate updated information to transmit to the computer," as claimed by Applicant in, for example, amended Claim 6. And, Fuchigami et al., like Cook do not suggest or describe any apparatus that includes "logic that detects the tracking information when the electronic medium is coupled with a computer," let alone such an apparatus that further includes "logic that transmits the tracking information to a server computer," as claimed, for example in amended Claim 6. (Fuchigami et al. do show a decoder circuit for extracting their copyright information, however, there is no suggestion that this decoder is included in a computer, a DVD player or any similar device, or that the output of the decoder is transmitted to a server.)

Thus, even if the teachings of Cook and Fuchigami et al. are combined, the claimed features set forth above are missing from the combination, because neither Cook nor Fuchigami et al. show or suggest these features. At most, a Cook/Fuchigami et al. combination would show an electronic medium into which is implanted copyright information, and the order tracking system as described by Cook. As the imbedding of copyright information, and order tracking function entirely separately, and there is no suggestion as to how or why they would or should be combined, Applicant believes that the Examiner is in error in making the present rejection. Furthermore, even if these functions were combined, the claimed invention would still not be attained.

Thus, reconsideration and withdraw of the present rejection is respectfully requested.

6. Claims 3 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Cook in view of Fuchigami et al. and U.S. Patent No. 5,410,343 (Coddington et al).

As pointed out above, the proposed Cook/Fuchigami et al. combination fails to show or suggest what is claimed by Applicant in Claims 1, 2, 4, 6, 7 and 9. And, as correctly pointed out by the Examiner, neither Cook nor Fuchigami et al. teaches the server computer performing a table lookup to determine one or more authorized titles as recited in the present Claim 3 and 8. Coddington et al. is directed to a telephone line-based Video-on-Demand system, entirely distinct from the order tracking and copyright protection functions performed Cook and Fuchigami et al. Thus, even a Cook/Fuchigami et al. combination would be directed to solving two distinct and entirely different problems, i.e., order tracking, and copyright protection from that addressed by Coddington et al.: i.e., telephone line-based Video-on-Demand.

Thus, even if Coddington et al. disclose performing a table lookup to a data base, no motive is provided by Cook, Fuchigami et al., or Coddington et al. to combine this feature with the functions performed by a Cook/Fuchigami et al. combination. At most a Cook/Fuchigami et al./Coddington et al. combination suggests three separate and distinct functions, i.e., order tracking, copyright protection, and Video-on-Demand; not the delivery of updated information to a computer based on tracking information detected upon insertion of an electronic storage medium into a computer, as claimed by Applicant. Thus, the addition of Coddington et al. to a combination of Cook and Fuchigami et al. will not render the

present Claims 3 and 8 obvious to one of ordinary skills at the time the invention was made.

7. The Examiner further rejected Claims 5, 10 through 12, and 14 through 17 under 35 U.S.C. 103(a) as being unpatentable over Cook in view of Fuchigami et al. and U.S. Patent No. 5,892,900 (Ginter et al.).

Applicant agrees with the Examiner that neither Cook nor Fuchigami et al. teach transaction data written to a database memorializing processing as recited in the present Claims 5 and 15, a program embodied on a computer readable medium for identifying and providing a response to the use of an electronic storage medium having an identifier incorporated thereon, as recited in Claims 10 through 12, and 14 through 17, the code segment that receives live update information from the server computer as recited in Claim 16, and a code segment that reads the identifier on the electronic storage medium upon being input into a computer by a user as recited in Claim 11. Further, for the reasons stated above, the combination of Cook and Fuchigami et al. do not provide motive to make the invention claimed in Claims 1, 2, 4, 6, 7, and 9. Furthermore, the Virtual Distribution Environment of Ginter et al., like the Video-on-Demand system of Coddington et al., provides no apparent benefit to a Cook/Fuchigami et al. combination for performing order tracking, and copyright protection. In other words, the functions of Ginter et al. are too remote from the functions of a Cook/Fuchigami et al. combination to suggest the claimed invention. At most a Cook/Fuchigami et al./Ginter et al. combination suggests three separate and distinct functions, i.e., order tracking,

copyright protection, and electronic distribution; not the delivery of updated information to a computer based on tracking information detected upon insertion of an electronic storage medium into a computer, as claimed by Applicant. Therefore, the combination of Ginter et al with Cook and Fuchigami et al will not render the present claims 5, 10 through 12, and 14 through 17 obvious to one of ordinary skill at the time the invention was made.

8. The Examiner further rejected Claim 13 under 35 U.S.C. 103(a) as being unpatentable over Cook in view of Fuchigami et al. and Ginter et al. and Coddington et al.

The present Claim 13 recites a server computer performing a table lookup to determine one or more authorized titles. As stated by Applicant above, neither Cook nor Fuchigami et al. teach the server computer performing a table lookup. Although Coddington et al. disclose a server computer performing a table look, the combination of Coddington et al. with Cook and Fuchigami et al. absent hindsight will not render Claim 13 obvious to one of the ordinary skills at the time the invention was made, because neither Coddington et al., nor Cook and Fuchigami et al. suggest such combination, and Coddington et al. is far too remote in function to motivate one of the ordinary skills to make the modifications to Cook and Fuchigami et al. That would be needed to suggest the claimed invention.

Newly submitted Claims 19 and 20 are believed to be allowable because they are directed to subject matter that which is not shown or suggested in the prior art. In

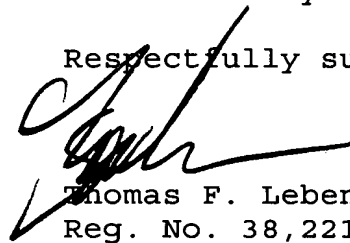
Amendment
S.N. 09/295,856
Page 19

particular, a combination of means for selecting content in response to the reading of information from a database in response to the reading of an identifier from an optical storage medium, and means for retrieval of that content is not shown in the prior art of record.

Applicant(s) acknowledge the objections made to the drawings in the NOTICE OF DRAFTSPERSON'S PATENT DRAWINGS REVIEW. Formal drawings will be forwarded to the U.S. Patent and Trademark Office upon receipt of a NOTICE OF ALLOWABILITY.

In view of the above, Applicants submit that Claims 1 through 20 are now in condition for allowance, and prompt and favorable action is earnestly solicited.

Respectfully submitted,



Thomas F. Lebens
Reg. No. 38,221
September 25, 2000

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
120 So. LaSalle Street, Suite 1600
Chicago, Illinois 60603

Direct telephone inquiries to:
Thomas F. Lebens
(858) 552-1311 or (805) 748-0594
La Jolla, California Office of
FITCH, EVEN, TABIN & FLANNERY

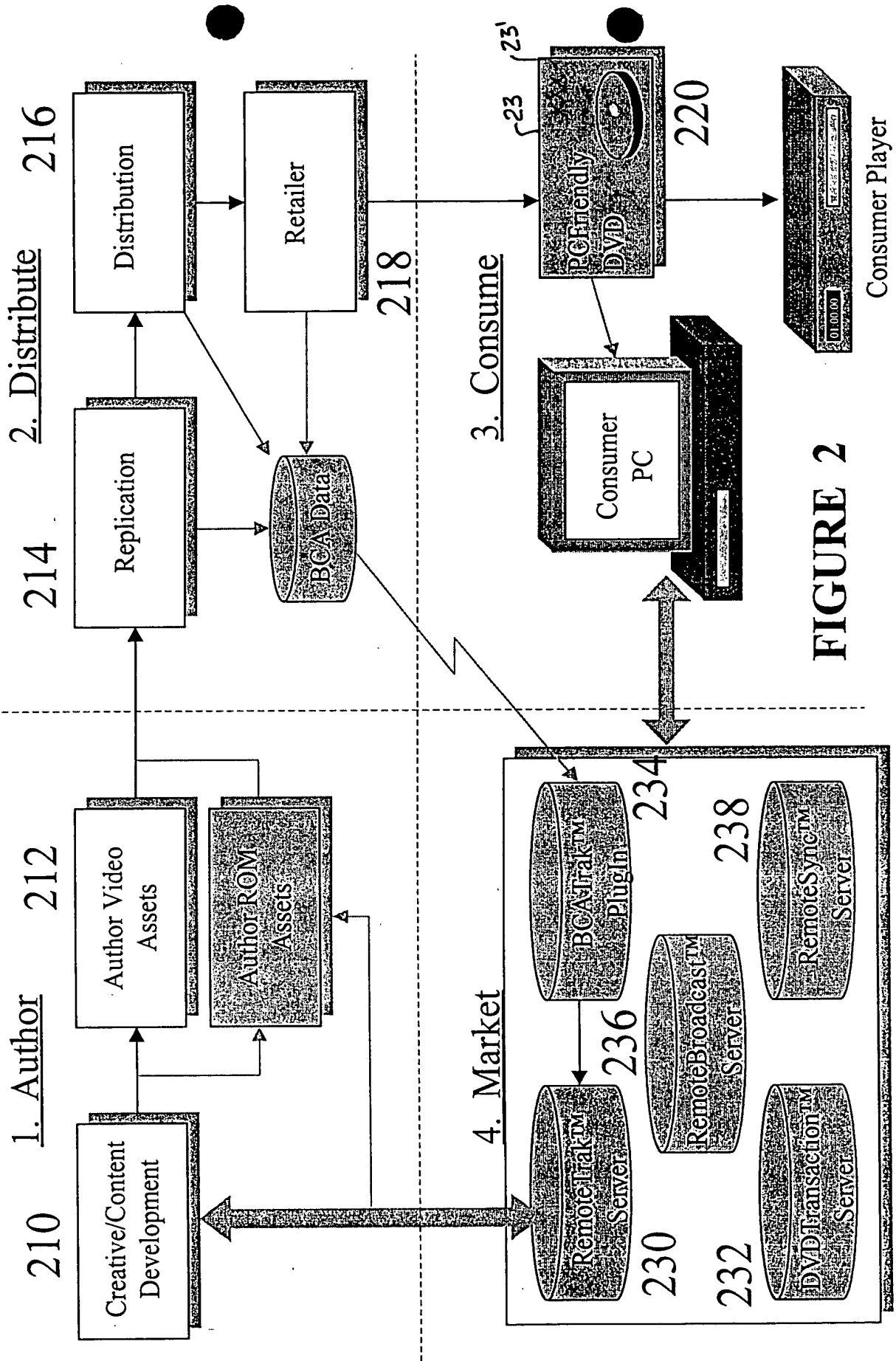


FIGURE 2

Approved 02/02/02

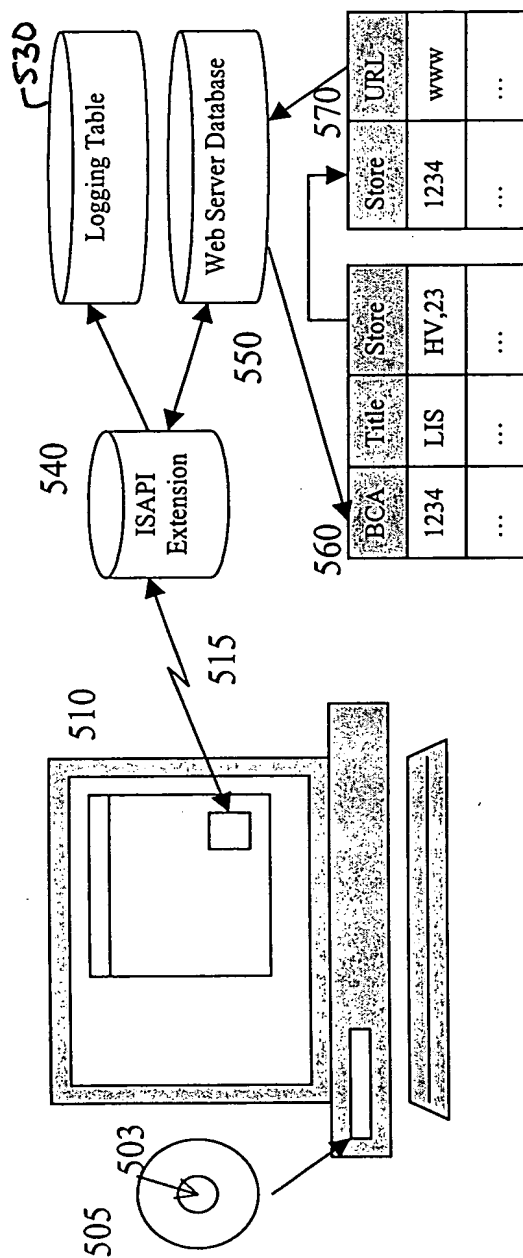


FIGURE 5